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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,142	01/25/2001	Spencer A. Rathus	660-023	8426

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EXAMINER	
LE, UYEN CHAU N	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/769,142	RATHUS ET AL.	
	Examin r	Art Unit	
	Uyen-Chau N. Le	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 June 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *168-289* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *168-289* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 25 June 2003.

Terminal Disclaimer

2. Receipt is acknowledged of the Terminal Disclaimer filed 19 June 2003.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 168-173, 176-178, 195-196, 220-241, 255-258, 263-265, 268, 279, 284 and 286-289 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al (US 4,488,035) in view of Fields (US 4,481,412) and Utsugi (US 4,601,573).

Re claims 168-173, 176-178, 195-196, 220-241, 255-258, 263-265, 268, 279, 284 and 286-289: Withnall et al discloses a system for displaying information to a user comprising a printed document having at least one machine recognizable feature (i.e., barcode); a feature recognition unit 18 having associated therewith a means for recognizing the machine recognizable feature (col. 4, lines 2-30); display the information on the portable handset illuminated display having a microprocessor with programmable memories (col. 5, lines 10-17).

Withnall et al fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal.

Fields teaches the above limitation with an accessing means 10 having a microcontroller 23 including a barcode electronic circuit 25 electrically coupled to the barcode reader 24 for transmitting/accessing the programming material in response to receiving the coded signal (fig. 2; col. 7, line 40 through col. 8, line 11); wherein the displayed data is a video/image/programming/sound/pictorial/electronic/media data and wherein the display 22 is a television/workbook (col. 6, lines 56-64 and col. 8, line 12 through col. 9, line 55).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Fields into the teachings of Withnall et al in order to provide Withnall et al with a higher technology system wherein the user being provided with a full

complete information in a flexible ways (i.e., video, pictorial, etc.), and therefore an obvious expedient.

Withnall et al as modified by Fields fails to teach or fairly suggest that the printed document is a printed photograph.

Utsugi teaches the above limitation with a printed photograph A having a barcode 14 for encoding information related to the photograph (e.g., photograph quality, location, photographer's name, etc.) (See fig. 3 and col. 4, lines 2-22).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Utsugi into the teachings of Withnall et al/Fields in order to provide Withnall et al/Fields with a capability of retrieving data related to a desired photograph readily from the barcode, which occupies a small amount of space, and thus providing a more feasible system due to the less consumption of ink and paper. Furthermore, such modification would provide Withnall et al/Fields with a more secure system for photograph's authorization, preventing fraudulent use in duplicating photographs (i.e., famous photographs/paintings, etc.).

6. Claims 174-175, 180-181, 183-184, 189-190, 192-193, 214-219 and 246-252 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields and Utsugi as applied to claim 168 above, and further in view of Roberts (US 5,324,922) and Malec et al (US 5,287,266). The teachings of Withnall et al as modified by Fields and Utsugi have been discussed above.

Re claims 174-175, 180-181, 183-184, 189-190, 192-193, 214-219 and 246-252: Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest feature for online/home shopping and the data link comprises a cable television line.

Roberts teaches the above limitation with a home/online shopping system (figs. 1-14; col. col. 1, lines 58+; col. 7, line 35 through col. 12, line 35).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Roberts into the teachings of Withnall et al/Fields/Utsugi with the latest technology for a faster system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi to provide the user an alternative way of doing shopping (i.e., shopping online/at home), and therefore an obvious expedient.

Withnall et al/Fields/Utsugi as modified by Roberts fails to teach or fairly suggest that the data link comprises an ISDN line.

Malec et al teaches the above limitation with the use of ISDN technology (col. 7, lines 1-12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Malec et al into the teachings of Withnall et al/Fields/Utsugi/Roberts in order to provide Withnall et al/Fields/Utsugi/Roberts with the latest technology for a more accurate and faster system due to the benefit of ISDN networking line. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi/Roberts and would have mere been a substitution of equivalents (i.e., to cable television line) well within the ordinary skill in the art, and therefore an obvious expedient.

7. Claims 179, 182, 286-288, 191, 194, 199-201, 203-204, 209-210, 213, 242-245, 253-254, 262, 267, 269-271, 282 and 285 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields and Utsugi as applied to claims 168 and 284 above, and further in view of Bravman et al (US 5,401,944). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 179, 182, 286-288, 191, 194, 199-201, 203-204, 209-210, 213, 242-245, 253-254, 262, 267, 269-271, 282 and 285: Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest that the displayed information including specific details related to traveling (e.g., seat location, departure terminal, hotel, restaurant, etc.), wherein the display unit comprising a wireless communication device (e.g., a remote unit).

Bravman et al teaches the above limitation with remote units 15 providing all necessary information related to traveling (i.e., seat assignment; airline/hotel/rental cars reservations, etc.) in col. 4, line 21 through col. 14, line 5 and col. 16, line 14 through col. 18, line 22.

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Bravman et al into the teachings of Withnall et al/Fields/Utsugi in order to provide Withnall et al/Fields/Utsugi with a more reliability system wherein the user being provided with a full and completed desired information about a trip that he/she is about to take so that he/she can plan it accordingly, and therefore an obvious expedient.

8. Claims 197, 202 and 205 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields/Utsugi as applied to claim 168 above, and further in view of Anmelder (DT 2,452,202 A1). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 202, 207 and 205, Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature is invisible.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall et

al/Fields/Utsugi in order to provide Withnall et al/Fields/Utsugi with a more secure system wherein the data recorded in the machine recognizable feature is invisible to naked eye, thus preventing manipulating by fraudulent user.

9. Claims 198 and 212 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields/Utsugi as applied to claim 168 above, and further in view of Tannehill et al (US 5,158,310). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 198 and 212, Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest that at least one machine recognizable feature comprises a magnetic code/strip.

Tannehill et al teaches the above limitation with the machine recognizable feature can be a barcode or a magnetic strip (col. 18, lines 7-12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Tannehill et al into the teachings of Withnall et al/Fields/Utsugi in order to provide Withnall et al/Fields/Utsugi with an alternative feature for encoding data. Furthermore, such modification would have mere been a substitution of equivalents well within the ordinary skill in the art to encode data, and therefore an obvious expedient.

10. Claims 206-208 and 211 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields/Utsugi as applied to claim 168 above, and further in view of Schach et al (US 5,397,156) and Anmelder (DT 2,452,202 A1). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 206-208 and 211, Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest that.

Schach et al teaches the above limitation with a machine recognizable feature 42 comprises a watermark (see abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Schach et al into the teachings of Withnall et al/Fields/Utsugi aesthetic purpose that would attracted more people to use and therefore an obvious expedient.

Withnall et al/Fields/Utsugi as modified by Schach et al fails to teach or fairly suggest that at least one machine recognizable feature comprises an invisible watermark.

Anmelder teaches the above limitation with the machine recognizable feature is invisible (see English abstract).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Anmelder into the teachings of Withnall et al/Fields/Utsugi/Schach et al in order to provide Withnall et al/Fields/Utsugi/Schach et al with a more secure system wherein the data recorded in the machine recognizable feature is invisible to naked eye, thus preventing manipulating by fraudulent user, and therefore an obvious expedient.

11. Claims 185, 259-261, 263, 267, 272-278, 280-281 and 283 are rejected under 35 U.S.C. 103(a) as being unpatentable over Withnall et al as modified by Fields as applied to claim 168 and 301 above, and further in view of Morales (US 5,872,589). The teachings of Withnall et al as modified by Fields/Utsugi have been discussed above.

Re claims 185, 259-261, 263, 267, 272-278, 280-281 and 283: Withnall et al/Fields/Utsugi have been discussed above but fails to teach or fairly suggest that the display unit comprises a personal planner/phone/pager.

Morales teaches the above limitation in figs. 2, 5, 8 & 9; col. 3, lines 28 through col. 7, line 12).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Morales into the teachings of Withnall et al/Fields/Utsugi in order to provide Withnall et al/Fields/Utsugi with an alternative system in which a user has a flexibility in selecting a desired display unit that fits his/her needs, and therefore an obvious expedient.

Response to Arguments

12. Applicant's arguments filed 25 June 2003 have been fully considered but they are not persuasive.

13. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Withnall et al discloses a printed document/ticket having a barcode; a means 18 for recognizing/reading the barcode; and means for displaying the read information. However, Withnall et al is silent with respect to transmit the read coded signal to an intelligent controller. The secondary reference to Fields teaches a barcode electronic circuit 25 electrically coupled to a barcode reader 24 for transmitting the read coded signal to a microcontroller 23. Nevertheless, Withnall et al as modified by Fields is silent with respect to a photograph having a barcode. The

third reference to Utsugi teaches a photograph [A] having a barcode 14. Accordingly, a barcode can be used in various applications (e.g., a barcode can be printed on a written document, a ticket, a confidential document, a picture, a photograph, etc.), can be read by a barcode reader/recognition machine, and can be decoded readily within the reader/machine or can be transmitted to a remote controller for decoding. Therefore, the claimed limitation, given the broadest reasonable interpretation, Withnall et al as modified by Fields and Utsugi meets the claimed invention (see the rejection above).

For the reasons stated above, the Examiner believes that a proper prima-facie case of obviousness has been established. Therefore, the Examiner has made this Office Action final.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 571-272-2397. The examiner can normally be reached on Mon-Fri. 5:30AM-2:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Uyen-Chau N. Le
May 26, 2004

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